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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/187,332	11/06/1998	JOE G. NAYLOR	JFX/027-98	2923

7590 06/16/2004
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EXAMINER

HARRELL, ROBERT B

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 06/16/2004

25

Please find below and/or attached an Office communication concerning this application or proceeding.

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PAPER NO. 25

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Before the Board of Appeals

MAILED

JUN 16 2004

Technology Center 2100

Examiner's Answer

This Examiner's Answer is in response to the Appellant's Appeal Brief filed March 30, 2004 (paper #24).

I. Real Party in Interest

A statement identifying the real party in interest is contained in the Appeal Brief and is acknowledged.

II. Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the Appeal Brief and is acknowledged.

III. Status of Claims

This is an Answer to an appeal from the final rejection of claims 19-36, which are all the claims in the case. Examiner agrees with the statement of the status of the claims contained in the appellant's Appeal Brief.

IV. Status of Amendments After Final

Examiner agrees with the statement of the status of amendments contained in the Appellant's Appeal Brief.

V. Summary of Invention

Examiner agrees with the summary of the invention contained in the Appellant's Appeal Brief.

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VI. Issues

Examiner disagrees with the issues presented for review as contained in the Appellant's Brief. The cited United States Patent Number for Ho et al. is incorrect as the Appeal Brief transposes the numbers "8" and "9". The corrected number is 5,805,298.

VII. Grouping of Claims

Examiner agrees with the grouping of the claims as contained in the Appellant's Appeal Brief.

VIII. Claims Appealed

Examiner agrees that the copy of the Appealed claims as contained in the appendix of the Appellant's Brief is correct.

IX. References of Record

The following is a listing of the references of record relied upon for establishing the rejection under 35 U.S.C. 103(a):

U.S. Patent 5,805,298 Ho et al. filed: May 8, 1996

U.S. Patent 5,870,089 Fabbio et al. filed: Nov 24, 1997

X. Grounds of Rejection

1. Claims 19-36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ho et al. (5,805,298) in view of Fabbio et al. (5,870,089).

2. Per claim 19, Ho taught the invention substantially as claimed, including a method comprising:

a) receiving from a user a facsimile telephone number or an electronic mail address of the same recipient, and storing the number or address in a memory of a facsimile machine (eg., see col. 6 (lines 31-48));

b) converting a document provided by the user to the facsimile machine into digital form (eg., see col. 4 (lines 10-22) and col. 7 (lines 31-53));

c) associating an actuator disposed on the facsimile machine to locations in the memory which contain the facsimile telephone number or the electronic mail address (eg., see figures 2 and 3, col. 5 (line 40-et seq.), and col. 6 (line 23-et seq.)); and,

d) transmitting the converted document to the facsimile telephone number or to the electronic mail address in response to the actuator being activated by the user (eg., see col. 6 (lines 24-48) to col. 7 (lines 14-17)).

3. While Ho did not specifically send the message via both by facsimile and e-mail "at the same time", such would have been obvious to those skilled in the art when taken Ho alone. That is, the message could first be sent by e-mail and then latter by facsimile or at the same time. Furthermore, on line 2 of Ho's Abstract and col. 2 (lines 19-22), Ho suggested transmitting both facsimile "and" electron mail. Since his device could do both, doing both at different times or at the same time would have been obvious to those skilled in the art. Also, sending the message by facsimile and e-mail would have been obvious to those skilled in the art when taking Ho in view of Fabbio who taught of sending electronic mail and facsimile (eg., see Fabbio in col. 3 (lines 4-23 "at the same time" on line

22)) at the same time. In fact, not only was the facsimile sent at the same time with the e-mail, they each were sent at the same time in addition and above the claimed subject matter to a printer (eg., see col. 3 (lines 4-23)).

4. It would have been obvious to have combined these references because they were both directed to sending electronic mail and facsimile to a recipient from a single device. Furthermore, col. 6 (lines 32-36) of Fabbio stated that the delivery service system 12 of figure 2 could be either a stand alone computer or a local area network (LAN) as called for by Ho in col. 3 (line 54) to col. 4 (line 6). Since Ho called for a LAN version, and Fabbio taught a LAN version, it would have been obvious to those skilled in the art to use Fabbio's system in Ho's system (specifically delivery server 12 of Fabbio's second figure for the PSTN 106 in Ho's first figure).

5. Per claim 20, Ho taught that his actuator was a button (eg., see figure 2(a)) which then transmitted the converted document once being pressed by a user (eg., see col. 6 (line 27) to col. 7 (line 17)).

6. Per claims 21,22, and 26 Ho taught that electronic mail was sent via a server (eg., see col. 3 (lines 58-61 "a commercial service which provides access to the Internet (i.e., An Internet Service Provider or Server"))(SLIP/PPP (ie., an Internet Service Provider over a packet switched data network (eg., see col. 4 (lines 1-6 "LAN" Local Area Network which is a packet switched data network))) and facsimile was sent to the recipient via a PSTN 106 in figure 1 and col. 3 (lines 32-43). A PSTN is a Public Switch Telephone Network having several computers. Also, Fabbio taught that the delivery server 12 (of figure 2) was a server (eg., see col. 6 (line 25-et seq.)).

7. Per claims 23-25, such is standard facsimile operations and was taught in Ho at col. 3 (lines 27-32) and 6 (line 27 et seq.)) in that a document was scanned and appropriate facsimile information (i.e., a cover sheet having the senders information, the recipient information, exc...) with the document parsed to ascertain where to send the document (eg., see col. 4 (line 23-et seq.)), or in Fabbio

(eg., see col. 6 (line 43-et seq.)). Since Optical Character Recognition is well known in the art, the scanner obviously could have been an alternative means of inputting such information rather than by use of a keyboard.

8. In conclusion, Ho taught the invention as claimed except for send both the fax and e-mail "at the same time". But since Ho could either fax or e-mail one or the other, Ho had the means for sending them at the same time when taking Ho alone; or, in light of Fabbio, sending a fax and an e-mail at the same time in Ho would have been obvious to those skilled in the art.

9. Per claims 27-36, these claims do not teach or define the above cited claims and thus stand rejected for the reasons outline above (eg., see col. 3 (line 29 "facsimile communications protocol" of Ho) for claim 29's BFT). More specifically, incorporating the above cited subject matter of a computer-readable memory would have been inherently required as each of Ho and Fabbio's systems were computer based and required a computer readable memory to store the instructions for the method as taught by the references.

XI. Response to Argument

1. Per the Appellant's remarks filed March 30, 2004 (paper #24), the Appellant argued in substance that:

a) only one opportunity is provided in Ho for the user to enter a single destination identifier, for a document to be transmitted by a single application of the Send button. This, therefore, does not teach or suggest receiving from the user a facsimile telephone number and an electronic e-mail address of the same recipient, and transmitting a converted document to both the facsimile telephone number and the e-mail address in response to the same instance of an actuator being activated by the user. However, col. 1 (line 46) states "when configured appropriately" and col. 2 (lines 13-15) states "a properly configured" clearly lays open an invitation to modify Ho's system beyond that which he disclosed as called for by col. 9 (lines 8-10). Thus while Ho sends either a fax or an e-mail, the simplistic

modification to send both at the same time was clearly obvious to those skilled in the art either in review of Ho alone or supported by Fabbio;

b) the Appellant's point here is that one of ordinary skill in the art who is concerned with improving the value of a facsimile machine as a stand alone, document transmission device, to deliver a message more reliably to the recipient, would not look to learn from the general purpose computer software system of Fabbio. However, Fabbio was provided to show the simplicity of sending a digitized document to more than one destination "at the same time". Clearly, in light of Ho's invitation to "modify" and/or "configure" his system, to send the fax and e-mail "at the same time" in Ho's infrastructure would have been obvious to those skilled in the art;

c) there is no suggestion that the destination identifiers of Fabbio be the same recipient. However, Patents are not granted on recipient addresses alone. To whom one sends messages is a matter of routine design choice. Clearly one skilled in the art would be cognizant of sending e-mail and a fax to the same owner of a fax machine and an e-mail box;

d) the reasoning provided by the examiner in finding that it would have been obvious to use the teachings of Fabbio to modify Ho is flawed and not reasonable because it attempts to replace a public switched telephone network with the functionality of a delivery server 12, namely, in this case, software running in a computer system or network. However, examiner is not stating that the whole of Ho's infrastructure should be modified to comply with that of Fabbio, rather that it would have been obvious to have transmitted a digitized document to more than one location;

e) there is no concern in either Ho or Fabbio that an intermediary server be used between the facsimile machine from which the facsimile and e-mail versions of the message originate, and their destinations. However, col. 3 (lines 58-61) clearly taught the use of "a commercial service".


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2. For all of the reasons set forth above, it is respectfully requested that the rejections as presented be sustained.

XII. Period for Response to New Ground of Rejection

No extension of time is permitted for filing a Replay Brief under 37 C.F.R. 1.136(a)


ROBERT B. HARRELL
PRIMARY EXAMINER

K. Appeal Conferee


JACK B. HARVEY
SUPERVISORY PATENT EXAMINER

Jack Harvey (Appeal Conferee-SPE)



Le Luu (Primary Examiner-Master Rating in Networking Art)